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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,180	11/13/2003	Hidetada Nago	1232-5208	9816

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EXAMINER

HOLLIDAY, JAIME MICHELE

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/713,180	NAGO, HIDETADA	
	Examiner	Art Unit	
	Jaime M. Holliday	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13, 14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2006 has been entered.

Response to Amendment

Response to Arguments

2. Applicant's arguments with respect to "REMARKS" page 13, **claims 1-5, 7-11, 13, 14, 16 and 17** have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed December 12, 2006 have been fully considered but they are not persuasive.

Applicant basically argues that Noda describes that local-network information required for wireless communication first is taken from PC 1-1 and stored onto IC card 2. Next, IC card 2 is brought in close proximity to IC-card contactless communication unit 19-2 of PC 1-2. The reader 19-2 then reads local-network information from PC 1-1 that is stored on the IC card 2. Applicant further argues that there is no disclosure in Noda that this reading step occurs in accordance with the local-network information,

Art Unit: 2617

and that certain information is exchanged between an IC card before the wireless link may be established and not after the link is established. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wireless link established between wireless communication apparatus and first apparatus is in accordance with the wireless communication setting information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-4, 7-10, 13, 16 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Noda (Pub # U.S. 2005/0015467 A1)** in view of **Beach (U.S. 2004/0076136 A1)**.

Consider **claims 1, 7 and 16**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer **1**, reading on the claimed "second communication apparatus," includes a CPU (central processing unit) **11**, which is connected to an input/output interface **15** via a bus **14**, and furthermore, a ROM (read only memory) **12** and a RAM (random access memory) **13** are connected to the bus. An IC-card contactless communication unit **19** for detecting an IC card **2**, reading on the claimed "wireless communication apparatus having a wireless communication unit and a memory," when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit **20** for forming a wireless link and exchanging data with, for example, the access-point device **3**, by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the CPU, (abstract, paragraphs 52-53). The personal computer **1-1**, reading on the claimed "second apparatus," starts processing when a user performs an operation for requesting that local-network information required for the personal computer **1-2**, reading on the claimed "first apparatus," to form a wireless link with the personal computer be recorded in the IC card. When the user places the IC card in proximity to the IC-card contactless communication

unit **19-1** of the personal computer, the IC-card contactless communication unit detects the IC card, and the IC-card contactless communication unit records the local-network information required for the personal computer **1-2** to form a wireless link with the personal computer **1-1** in the IC card, reading on the claimed "registration step," (paragraphs 78 and 80). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card, reading on the claimed "reading step." The CPU **11-2** sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless communication unit, reading on the claimed "setting step." Thus, a wireless LAN is formed between the personal computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the claimed "communication method for allowing a first apparatus connected to a wireless communication apparatus having a wireless communication unit and a memory, to perform wireless communication via the wireless communication apparatus, said communication method comprising:

a registration step registering, while said wireless communication apparatus is connected to a second apparatus, wireless communication setting information, in said memory of by said second apparatus; and

a reading step of reading, in a case that said wireless communication apparatus where the wireless communication setting information has been registered in said registration step is connected to said first apparatus, the wireless communication setting information from said memory by said first apparatus," (paragraphs 84 and 85).

However, Noda fails to specifically disclose the PC's communicating via the IC-card contactless communication unit.

In the same field of endeavor, Beach clearly shows and discloses a method for wireless data communications between a mobile unit and an access point of a network and between the mobile unit and at least one peripheral device, reading on the claimed "first apparatus." A second control program includes a network communications program to cause the at least one peripheral device to become associated with an access point connected to a network including the at least one computer, reading on the claimed "wireless communication unit," and to engage in data communications using the first communications protocol. In this arrangement a first control program may be arranged to cause the first data communication device to communicate directly with the peripheral device when the first communications device is in direct communications with the second communications device and to communicate with the second communications device via the network when the first communications device is not in direct communication with the second communications device, reading on the claimed "first apparatus performs

wireless communications via said wireless communication unit, a communication step of performing wireless communication by said wireless communication unit in accordance with the wireless communication setting information, whereby the wireless communication by said first apparatus is achieved," (paragraphs 9, 13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a peripheral device communicate wirelessly via a mobile unit as taught by Beach, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

Consider **claims 2 and 8**, Noda, as modified by Beach, clearly show and disclose the claimed invention **as applied to claims 1 and 7**, respectively, and in addition, Noda further discloses that the predetermined wireless communication standard carried out by a first communication apparatus is IEEE 802.11b, reading on the claimed "the setting information includes information relating to a wireless LAN," (paragraphs 10 and 11).

Consider **claims 3 and 9**, Noda, as modified by Beach, clearly show and disclose the claimed invention **as applied to claims 2 and 8**, respectively, and in addition, Noda further discloses that the personal computer requires an SSID and a WEP KEY defined in IEEE 802.11b to be set before forming a wireless link with the access-point device, reading on the claimed "the setting information includes any of Service Set ID and Wireless Equivalent Privacy Key relating to wireless LAN communication," (abstract, paragraph 50).

Consider **claims 4 and 10**, Noda, as modified by Beach, clearly show and disclose the claimed invention **as applied to claims 1 and 7**, respectively, and in addition, Noda further discloses that the setting information may include at least one of ID information, a password associated with the ID information, a user name, and a password associated with the user name, reading on the claimed "the setting information includes identification information of said first apparatus," (paragraph 15).

Consider **claims 13 and 17**, Noda clearly shows and discloses communication apparatus and method that allow setting for forming a wireless link. A personal computer, reading on the claimed "second communication apparatus," includes a CPU (central processing unit), which is connected to an input/output interface via a bus, and furthermore, a ROM (read only memory) and a RAM (random access memory) are connected to the bus. An IC-card contactless communication unit for detecting an IC card, reading on the claimed "communication apparatus," when it is placed in close proximity thereto and reading data from and writing data to the IC card, a wireless communication unit for forming a wireless link and exchanging data with, for example, the access-point device, reading on the claimed "first communication apparatus," by a wireless communication function conforming to IEEE 802.11b, according to access-point information, local-network information, or the like that is set by the CPU, (abstract, paragraphs 52-53). A first communication apparatus that includes wireless communication means for carrying out wireless communication

with another electronic apparatus based on a predetermined wireless communication standard and reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means. Since the access-point device is capable of writing data to the IC card, it is possible to additionally record user information for forming a link with a wireless LAN that is formed via the access-point device, (fig. 1, paragraphs 10 and 69). When the user places the IC card in proximity to the IC-card contactless communication unit **19-2** of the personal computer **1-2**, the IC-card contactless communication unit detects the IC card, and determines whether local-network information is recorded in the IC card. If it is determined that local-network information is recorded in the IC card, the IC-card contactless communication unit reads the local-network information recorded in the IC card. The CPU **11-2** sets network configuration of the wireless communication unit **20-2** according to the local-network information read by the IC-card contactless communication unit. Thus, a wireless LAN is formed between the personal computer **1-1** and the personal computer **1-2** in ad-hoc mode, reading on the claimed "detection means for detecting a connection with said wireless communication apparatus;

reading means for reading wireless setting information, for which said first apparatus connected to said wireless communication apparatus performs wireless communication, registered in a memory of said wireless communication

apparatus by a second apparatus in accordance with the result of detection by said detection; and

setting means for setting the wireless communication setting information read by said reading means in said wireless communication unit as wireless communication parameters for which said wireless communication unit performs the wireless communication," (paragraphs 84 and 85).

However, Noda fails to specifically disclose the PC's communicating via the IC-card contactless communication unit.

In the same field of endeavor, Beach clearly shows and discloses a method for wireless data communications between a mobile unit and an access point of a network and between the mobile unit and at least one peripheral device, reading on the claimed "first apparatus." A second control program includes a network communications program to cause the at least one peripheral device to become associated with an access point connected to a network including the at least one computer, reading on the claimed "wireless communication unit," and to engage in data communications using the first communications protocol. In this arrangement a first control program may be arranged to cause the first data communication device to communicate directly with the peripheral device when the first communications device is in direct communications with the second communications device and to communicate with the second communications device via the network when the first communications device is not in direct communication with the second

communications device, reading on the claimed "first apparatus performs wireless communications via said wireless communication unit of said wireless communication apparatus, wherein said wireless communication apparatus performs wireless communication based on the wireless communication setting information set in said wireless communication unit, whereby the wireless communication by said first apparatus is achieved," (paragraphs 9, 13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a peripheral device communicate wirelessly via a mobile unit as taught by Beach, in the system of Noda, in order to form a wireless link between two apparatuses in a wireless system.

7. **Claims 5, 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Noda (Pub # U.S. 2005/0015467 A1)** in view of **Beach (U.S. 2004/0076136 A1)**, and in further view of **Sato (Pub # U.S. 2003/0009541 A1)**.

Consider **claims 5 and 11**, and as applied to **claims 1 and 10**, respectively, Noda, as modified by Beach, clearly shows and discloses the claimed invention except that the setting information on the IC card is compared to information already stored on the second personal computer or access point.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a network, and a management device that manages the target device, reading on the claimed "first and second communication devices," wherein the management

device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, reading on the claimed "communication method and apparatus for connecting a communication apparatus to a first apparatus and performing communication, comprising: a registration step of connecting said communication apparatus to a second apparatus, and registering setting information for said first apparatus in said communication apparatus via said second apparatus," (paragraph 10). When a user of the management device **10** withdraws an IC card **50** from the IC card driver **20** of the management device, and carries and inserts the IC card into the IC card driver **70** of the network apparatus **60**, the controller **61** reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface **66** on the storage part **65**. The controller is required to identify the communication parameters on the pertinent network apparatus among those

stored in the IC card. For example, if user ID and password pairs are stored in the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "comparison step of comparing the identification information registered at said registration step with identification information of said first apparatus previously set in said first apparatus, wherein said first apparatus controls performing the wireless communication in said communication step in accordance with the result of comparison at said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, as modified by Beach, in order to form a wireless link between two apparatuses in a wireless system.

Consider **claim 14**, and **as applied to claim 13 above**, Noda, as modified by Beach," further discloses a first communication apparatus that includes wireless communication means for carrying out wireless communication with another electronic apparatus based on a predetermined wireless communication standard, reading means for reading the setting information, by contactless communication, from an information recording medium detected by a detection means, and setting means for adjusting setting of the wireless communication means according to the setting information read by the reading means, reading

on the claimed "reading means reads the setting information," (fig. 1, paragraphs 10 and 69).

However, Noda, as modified by Beach, fails to disclose that the setting information on the IC card is compared to information already stored on the second personal computer or access point.

In the same field of endeavor, Sato clearly shows and discloses a network system that comprises a target device to be managed that is connected to a network, and a management device that manages the target device, reading on the claimed "first and second communication devices," wherein the management device enables the target device to establish communications over the network and includes a first integrated circuit (IC) card drive in which an IC card stores communication parameters for enabling the management device to manage the target device, and wherein the target device includes a second IC card drive for reading the communication parameters stored in the IC card to set the communication parameters that have been read. The network system uses the IC card as a relay to perform an initial setting of the communication parameters on the target device. This enables the communication parameters to be set only by insertion of the IC card into the target device, achieving a relatively easy setting operation, reading on the claimed "communication method and apparatus for connecting a communication apparatus to a first apparatus and performing communication, comprising: a registration step of connecting said communication apparatus to a second apparatus, and registering setting information for said first

apparatus in said communication apparatus via said second apparatus," (paragraph 10). When a user of the management device withdraws an IC card from the IC card driver of the management device, and carries and inserts the IC card into the IC card driver of the network apparatus, the controller reads and sets some of the communication parameters stored in the IC card corresponding to the pertinent network apparatus. More specifically, the controller sets the communication parameters obtained through the IC card drive and the interface on the storage part. The controller is required to identify the communication parameters on the pertinent network apparatus among those stored in the IC card. For example, if user ID and password pairs are stored in the IC card, the controller may invite a user of the network apparatus to enter his/her user ID/password pair, and set the identified communication parameters, reading on the claimed "second reading means for reading the identification information from said wireless communication apparatus; and comparison step of comparing the identification information registered at said registration step with identification information of said first apparatus previously set in said first apparatus, wherein at said establishment step, the communication is established in accordance with the result of comparison at said comparison step," (paragraphs 71-75).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a step of verifying user ID and password as taught by Sato, in the system of Noda, as modified by Beach, in order to form a wireless link between two apparatuses in a wireless system.

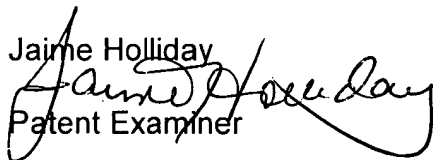
Art Unit: 2617


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jaime Holliday

Patent Examiner


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